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WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206			SHEPPERD, ERIC W	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/690,046	Applicant(s) HERZ ET AL.
	Examiner ERIC W. SHEPPERD	Art Unit 2492

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 February 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 and 10-14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-8 and 10-14 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 16 October 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/06)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

1. Claims 1-8 and 10-14 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal (As no Appeal Brief was filed). Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114.
Applicant's submission filed on 02/21/2006 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1-8 and 10-14 have been considered but are moot in view of the new ground(s) of rejection.

Priority

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

5. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

6. The disclosure of the prior-filed application, Application No. **09/314,321**, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claimed subject matter comprising "travel route history database" and "sensor data from vehicle" are missing from the prior-filed application. Accordingly, claims 3 and 8 are not entitled to the benefit of the prior-filed application.

7. The disclosure of the prior-filed application, Application No. **08/985,731** (claimed by way of 09/314,321), fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claim subject matter pertaining to "mobility" is missing from the prior-filed application. All of the claims currently presented are not entitled to the benefit of the prior-filed application or any parent application of said prior-filed application.

8. The disclosure of the prior-filed application, Application No. **09/024,278**, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claim subject matter pertaining to "travel route history database", "public/private information stream", "current

trip vector" and "sensor data from vehicle" is missing from the prior-filed application. Accordingly, claims 3-5 and 8 are not entitled to the benefit of the prior-filed application).

9. The disclosure of the prior-filed application, Application No. **08/550,866** (by way of 09/024,278), fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Claimed subject matter pertaining to "mobility" is missing from the prior-filed application or any parent application of said prior-filed application.
All of the claims currently presented are not entitled to the benefit of the prior-filed

application or any parent application of said prior-filed application.
10. The disclosure of the prior-filed application, Application No. **08/346,425** (by way of 09/024,278), fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Claimed subject matter pertaining to "mobility" is missing from the prior-filed application.
All of the claims currently presented are not entitled to the benefit of the prior-filed application or any parent application of said prior-filed application.

Claim Objections

11. Claim 2 and 7 are objected to because of the following informalities: Claim 2 line 8 and 9 uses "(1)" and "(2)" to reference optional limitations. Numbers used in parenthesis are used to refer to the drawings (see MPEP 608.01(m)), the indicators should be changed or removed. Claim 7 line 4, the number "10" is apparently a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-8, 10-14 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

14. Claims 1-8 and 10-11 fail the machine-or-transformation test which is a two-branched inquiry. It may be shown that a process claim satisfies 35 USC § 101 by showing that a claim is tied to a particular machine or by showing that a claim transforms an article into a different state or thing. See *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). As to the first prong (machine), the Examiner cannot find any showing that these claims are attached to a specific machine. As to the second prong (transformation), the process claims do not transform a physical article into a different state or thing. The process claims are merely manipulating abstract data without regard to any physical article or object.

15. Claims 12-13 further fail to recite any positive structural limitations to overcome the 101 issues discussed above, and are also rejected.

16. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is drawn to a system comprising "one or more network nodes". Lacking any description in the specification for "network nodes", the claimed management system is broadly interpreted to encompass various computer programs (i.e. software). Thus, it is not clear whether the

claimed elements are tangibly-embodied structural features, or computer programs, per se. Computer software does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C § 101 (process, machine, manufacture or composition of matter).

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

18. Claims 11 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Marlevi et al (US 5,572,221).

19. As to claim 11, Marlevi anticipates a method of communicating content to a mobile user (*Marlevi Abstract*), the method comprising computer-implemented acts of:

- (a) acquiring location information corresponding to the mobile user (*Marlevi column 3 lines 1-8 current location of mobile terminal*);
- (b) determining content to deliver to the mobile user based at least in part on said location information (*Marlevi column 4 line 67 – column 5 line 2 distributes location sensitive information to servers*); and
- (c) communicating the determined content to the mobile user (*Marlevi column 4*

lines 60-63 *mobile terminal accessing files on servers*).

20. As to claim 14, Marlevi anticipates a system for communicating content to a mobile user using a communications network (Marlevi *Abstract*), the system comprising:
one or more network nodes on the communications network (Marlevi Fig. 2 item 110 "Base station" *for wireless networking*) operative to acquire location information corresponding to the mobile user (Marlevi column 3 lines 1-8 *current location*), to determine content to deliver to the mobile user based at least in part on the location information (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*), and to communicate the determined content to the mobile user (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-8, 10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marlevi et al (US 5,572,221), in view of Hoffberg et al (US 5,875,108).

23. As to claim 1, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

- (a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);
- (d) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*) based upon location information for the particular communicant (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) accessing a personal profile for said particular mobile communicant; and preferences identified in said personal profile.

Hoffberg describes a system for providing content based on a predicted desired user function.

With this in mind, Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 “User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*”). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

24. As to claim 2, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

- (a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);
- (d) determining a current location and a predicted future location of said particular mobile communicant (Marlevi column 3 lines 1-8 *current location and predicting next location*); and
- (e) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*) based upon at least one of: (1) said current location, and (2) said predicted future location (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers based on predicted next location*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) accessing a personal profile for said particular mobile communicant; and preferences identified in said personal profile.

Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 "User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

25. As to claim 3, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

- (a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);
 - a travel route history database (Marlevi column 7 lines 16-28 *itinerary pattern database (IPB) has history of terminal locations*); and
- (d) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*)

based upon information from said travel route history database (Marlevi column 7 lines 24-26 *IPB used for predicting next location*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) accessing a personal profile for said particular mobile communicant.

Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference profile/predicative system of Hoffberg with the location database predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

26. As to claim 4, Marlevi substantially discloses a method of communicating electronically (Marlevi *Abstract*), comprising:

(a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);

(d) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) accessing a personal profile for said particular mobile communicant; and (d) preferences identified in said personal profile, wherein said digital content includes combinations of a public information stream and a private information stream.

Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 "User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*), wherein said digital content includes combinations of a public information stream and a private information stream (Hoffberg column 28 lines 31-37 *real-time data stream*; and column 61 lines 29-34 *public/private key encryption of data*). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

27. As to claim 5, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

(a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for

a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);

(d) generating a current trip vector based upon acquired location information (Marlevi column 7 lines 7-13 *current speed and direction determined*); and

(e) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*) based upon said current trip vector (column 7 lines 10-15 *data pre-fetching performed as a result of direction determined*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) accessing a personal profile for said particular mobile communicant; and preferences identified in said personal profile.

Hoffberg describes a system for providing content based on a predicted desired user function.

With this in mind, Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 “User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*”). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predictive system of Hoffberg with the

location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

28. As to claim 6, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

(a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);

(c) utilizing conditional probability to identify a plurality of potential future locations for said particular mobile communicant (Marlevi column 4 lines 9-20 *stored sequence of locations selected based on ratio or quantitative measure of relevance to current location*);

(e) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*); and

(f) delivering digital content to selected ones of said plurality of potential future locations for pre-caching in memory for future use (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers based on predicted next location*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant;

(d) accessing a personal profile for said particular mobile communicant; and preferences identified in said personal profile.

Hoffberg describes a system for providing content based on a predicted desired user function.

With this in mind, Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (d) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 "User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*"). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

29. As to claim 7, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

(a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);

(d) utilizing autonomous user-side agents to negotiate terms and conditions

(Marlevi column 15 lines 42-46 *agents representing users on network*); and

(e) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*) based upon said negotiated terms and conditions (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers based on predicted next location*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) accessing a personal profile for said particular mobile communicant; the receipt of an advertisement and preferences identified in said personal profile.

Hoffberg describes a system for providing content based on a predicted desired user function.

With this in mind, Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); the receipt of an advertisement (Hoffberg column 62 lines 14-22 *characterization of program (i.e. advertisement for TV show) provided to user*) and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 "User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location

predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

30. As to claim 8, Marlevi substantially discloses a method of communicating electronically (Marlevi *Abstract*), comprising:

- (a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*); and
- (e) delivering digital content (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers*) to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant; (c) acquiring sensor data from a vehicle associated with said particular mobile communicant at a location remote from the vehicle; (d) accessing a personal profile for said particular mobile communicant; and preferences identified in said personal profile.

Hoffberg describes a system for providing content based on a predicted desired user function.

With this in mind, Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) acquiring sensor data from a vehicle associated with said particular mobile communicant at a location remote from the vehicle (Hoffberg column 111 lines 30-67 *vehicle sensor data*

*being transmitted to centralized station); (d) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 “User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).*

31. As to claim 10, Marlevi substantially discloses a method of communicating electronically (*Marlevi Abstract*), comprising:

(a) acquiring location information (Marlevi column 3 lines 1-8 *current location*) for a plurality of mobile communicants (Marlevi column 2 lines 59-61 *mobile radio transceivers*);

(d) delivering digital content, which corresponds to predicted information needs of said particular mobile communicant (Marlevi column 4 line 67 – column 5 line 2 *distributes location sensitive information to servers based on predicted next location*), to said particular mobile communicant (Marlevi column 4 lines 60-63 *mobile terminal accessing files on servers*).

Marlevi fails to explicitly disclose (b) identifying a particular mobile communicant;

(c) accessing a personal profile for said particular mobile communicant; and preferences identified in said personal profile.

Hoffberg describes a system for providing content based on a predicted desired user function.

With this in mind, Hoffberg discloses (b) identifying a particular mobile communicant (Hoffberg column 80 lines 61-65 *user is identified to system*); (c) accessing a personal profile for said particular mobile communicant (Hoffberg column 79 lines 18-22 *accessing user profile via network*); and preferences identified in said personal profile (Hoffberg Fig. 24 item 2406 "User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*"). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

32. As to claim 12, Marlevi substantially discloses the invention as claimed as discloses in claim 11, failing however to explicitly include further comprising:

(d) acquiring user preference information specifying one or more preferences of the user; wherein the act (b) comprises determining the content based at least in part on the user preference information.

Hoffberg discloses (d) acquiring user preference information specifying one or

more preferences of the user (Hoffberg Fig. 24 item 2406 "User History Database & Preferences; and column 35 lines 5-6 *preferences in user profile*); wherein the act (b) comprises determining the content based at least in part on the user preference information (Hoffberg column 34 lines 59-65 *determining program preference based on user preference information*). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to combine the user preference/predicative system of Hoffberg with the location predicative system of Marlevi as both systems deal with increasing the relevancy of provided content, and reducing the time necessary to provide relevant content (Hoffberg column 26 lines 42-48).

33. As to claim 13, the above combined art of Marlevi and Hoffberg disclose the invention as claimed as described in claim 12, including further comprising:

(e) accessing a personal profile of the user that includes the user preference information (Hoffberg column 79 lines 18-22 *accessing user profile via network*).

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yogo (US 5,548,822), Wong (US 5,408,419), Gooch (US 5,396,540) and Pearce (GB 2 277 844 A) are all related to position determination.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC W. SHEPPERD whose telephone number is

(571)270-5654. The examiner can normally be reached on Monday - Thursday, Alt. Friday, 7:30 AM - 5PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. W. S./
Examiner, Art Unit 2492

/Zachary A Davis/
Primary Examiner, Art Unit 2492